

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. HALE

Appeal No. 96-1604
Application 08/272,906¹

ON BRIEF

Before COHEN, LYDDANE and STAAB, Administrative Patent Judges.
LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal
to allow claims 6 through 9, 13, 14, 22 and 23. Claims 17
through 20, which are the only other claims pending in the

¹ Application for patent filed July 8, 1994. According to appellant this application is a continuation of Application 08/056,954, filed May 3, 1993, now abandoned; which is a continuation of Application 07/927,866, filed August 10, 1992, now Patent No. 5,244,108 issued September 14, 1993.

application, stand withdrawn from further consideration by the examiner pursuant to the provisions of 37 CFR § 1.142(b) as being drawn to a nonelected invention.

The subject matter on appeal is directed to a collapsible container. Claim 6 is exemplary of the invention and reads as follows:

6. An easily collapsible to save space container that may be readily reassembled without special tools comprising:

a plurality of reusable identical and nestable U-shaped continuously slightly curved and convex relatively rigid molded sidewalls and rounded corners, each sidewall being defined between two longitudinal edges;

an equal plurality of reusable H-shaped connectors for connecting said sidewalls by said edges to form a generally rectangular tubular body with slightly curved and convex sidewalls connected with rounded corners each of said edges being located intermediate a sidewall and between a pair of rounded corners, said connectors having grooves so shaped and dimensioned to form an interference fit with said edges so that the side walls and connectors may be assembled and disassembled without special tools;

a top member including a top plate and a top skirt extending below said top plate and arranged and constructed to form an interference fit with said tubular body when said tubular body is telescopically joined to said top member; and

a bottom member including a bottom plate and a bottom skirt extending above said bottom plate and arranged and constructed to form an interference fit with said tubular body when said tubular body is telescopically joined to said bottom member.

Appeal No. 96-1604
Application 08/272,906

The references of record relied upon by the examiner
in rejections of the claims under 35 U.S.C. § 103 are:

Sherk	1,511,915	Oct. 14, 1924
Carpenter, Sr. (Carpenter)	3,042,288	July 3, 1962
Sproull et al. (Sproull)	3,291,362	Dec. 13, 1966
Hancock	3,854,269	Dec. 17, 1974
DeForest et al. (DeForest)	4,157,147	June 5, 1979
Linnemann	4,881,683	Nov. 21, 1989

Claims 6 through 9 and 22 stand rejected under 35 U.S.C.
§ 103 as being unpatentable over Sproull in view of Carpenter,
Hancock and Sherk.

Claim 13 stands rejected under 35 U.S.C. § 103 as being
unpatentable over Sproull in view of Carpenter, Hancock, Sherk
and DeForest.

Claims 14 and 23 stand rejected under 35 U.S.C. § 103 as
being unpatentable over Sproull in view of Carpenter, Hancock,
Sherk and Linnemann.

Rather than reiterate the examiner's statement of the
above rejections and the conflicting viewpoints advanced by the
examiner and the appellant, we refer to pages 3 through 8 of the
examiner's answer and to pages 3 through 9 of the appellant's
brief for the full exposition thereof.

OPINION

At the outset, we note that both the appellant and the examiner agree that claims 6 through 9 and 22 stand or fall together and claims 13, 14 and 23 stand or fall together².

In arriving at our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art, and to the respective positions advanced by the appellant and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to all claims on appeal. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A prima facie case of obviousness is established by presenting evidence indicating that the reference teachings would appear to be sufficient for one of

² Note page 3 of the appellant's brief and page 2 of the examiner's answer.

ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988), Ashland Oil, Inc. v. Delta Resins & Refractories, Inc, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984), and In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

Additionally, rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that

the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we turn to the patent to Sproull applied by the examiner in the rejection of appealed claims 6 through 9 and 22. Sproull (Figures 1 and 2) discloses a fiberboard hogshead formed by interconnecting two fiberboard semi-cylindrical body halves 12A, 12B via a "slide fastener or zipper means 14 (column 5, line 37-38). The hogshead may include top and bottom members, or end closures, 16' (note Figures 8 and 9) that include central panels 60, an upstanding vertical wall 62, an arcuate web 64, and a downwardly extending, generally vertical skirt portion 66. The end closures 60 are secured to the body halves 12A, 12B by fasteners 74. Critical to the construction of

the fiberboard hogshead of Sproull is the requirement that "the hogshead must be constructed to diametrically enlarge 8% beyond its initial dimensions during a pressing operation" (column 6, lines 5-7). Sproull allows for this diametrical enlargement by either forming each zipper tape section 20 with a stretchable portion (column 5, lines 50-51 and column 6, lines 7-14) or by forming the body "in whole or in part of an extensible paper, which, in itself, could stretch during the pressing operation" (column 6, lines 15-17).

In rejecting appealed claims 6 through 9 and 22, the examiner has applied the additional teachings of Carpenter, Hancock and Sherk. Carpenter has been applied for its teaching of a fiberboard container having curved sidewalls and rounded corners (Figures 1 and 4). Hancock has been applied for its teaching of an H-shaped connector (Figure 12) for joining edges of panels to form a knockdown container, and Sherk has been applied to show a fiberboard container having end closures with skirts 18 extending below (or above) the planar plate portion of the end closure (Figure 5).

As noted above, the initial burden of establishing a prima facie case of obviousness rests upon the examiner. In establishing a prima facie case of obviousness under 35 U.S.C. § 103,

it is incumbent upon the examiner to provide a reasonwhy one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988).

It is our opinion that nothing in the teachings of the applied prior art or the knowledge generally available to one of ordinary skill in the art would have led such person of ordinary skill in the art to modify the fiberboard hogshead of Sproull to include the H-shaped connector of Hancock or the downwardly (or upwardly) extending skirt portions for the end closures of Sherk. In particular, although Hancock does disclose a removable H-shaped connector for connecting panels of a container, it is not apparent that such a connection would provide the necessary

resistance to the diametrical expansion forces critical to the manner in which the hoghead of Sproull functions. We recognize that Sproull discloses that either the walls of the container or the attachment tapes of the zipper means can be elastic. However, the fastener (zipper) itself and its connection to the panel ends must be of sufficient rigidity and strength to maintain the connection during the stretching of the elastic portions caused by the diametrical expansion. Nothing in the disclosure of Hancock indicates that the H-shaped connector is intended to function, or is even capable of functioning, in a manner to preclude separation of the panel connection during diametrical expansion of container walls formed thereby.

As stated in W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our conclusion that the only reason to combine the teachings of the applied references in the manner proposed by the examiner results from a review of appellant's disclosure

and the application of impermissible hindsight, since it does not appear from the disclosure of Hancock that any similar diametrical expansion is contemplated for the knockdown container thereof. Thus, we cannot sustain the examiner's rejection of appealed independent claims 6 and 22, or of claims 7 through 9 dependent from claim 6, under 35 U.S.C. § 103 for this reason alone.

Moreover, it is also not apparent from the disclosure of Hancock that the H-shaped connector thereof includes "grooves so shaped and dimensioned to form an interference fit" with the longitudinal edges of the panels in the manner disclosed and claimed by appellant. The H-shaped connectors and edging strips of Hancock "are arranged to be snap fitted together" (column 4, line 54), which would not necessarily result in an interference fit. Furthermore, the H-shaped connectors of Hancock do not engage the longitudinal edges of molded sidewalls as disclosed and claimed by appellant, rather they engage an "edging strip" that is crimped onto the edges of the panels to be joined. Thus, even assuming arguendo that the teachings of Hancock could be combined with those of Sproull, the container structure resulting therefrom would not include the longitudinal edges of the molded

sidewalls engaging with the grooves of the H-shaped connectors in an interference fit as required by appealed independent claims 6 and 22. Therefore, we also cannot sustain the examiner's rejection of claims 6 through 9 and 22 under 35 U.S.C. § 103 for this additional reason.

Furthermore, like the appellant, we are unable to find any teaching suggestion or motivation for modifying the end closures of Sproull to include skirt portions 18 as taught for the end closures of the ice cream container of Sherk. We observe that the end closures 16' of Sproull (Figure 8) already include downwardly (or upwardly) extending skirt portions 66, and it is not seen why one of ordinary skill in the art would have been led to the teachings of Sherk to have the portions 66 extend even farther downwardly past the plate portion 60, other than by utilizing appellant's claim as a template and the application of impermissible hindsight. Thus, we consider the examiner's rejection of claims 6 through 9 and 22 under 35 U.S.C. § 103 to be defective for this further reason.

We have also considered the teachings of the patents to DeForest and Linnemann as applied in the rejections of claims 13, 14 and 23 under 35 U.S.C. § 103, but we find nothing therein to cure the deficiencies of the rejection based on the combined

Appeal No. 96-1604
Application 08/272,906

teachings of Sproull Carpenter, Hancock and Sherk as set forth above. Therefore, the examiner's rejection of these claims under 35 U.S.C. § 103 also cannot be sustained.

Accordingly, the decision of the examiner rejecting claims 6 through 9, 13, 14, 22 and 23 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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WILLIAM E. LYDDANE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
LAWRENCE J. STAAB)	
Administrative Patent Judge)	

Appeal No. 96-1604
Application 08/272,906

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